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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/712,587 | 11/12/2003 | Hideo Suzuki | 393032019710 | 8984 |
| 25224 | 7590 | 07/02/2007 | EXAMINER | |
| MORRISON & FOERSTER, LLP | | | ZHOU, TING | |
| 555 WEST FIFTH STREET | | | | |
| SUITE 3500 | | | ART UNIT | PAPER NUMBER |
| LOS ANGELES, CA 90013-1024 | | | 2173 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/712,587 | SUZUKI ET AL. | |
| | Examiner | Art Unit | |
| | Ting Zhou | 2173 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11/12/2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 2,3,10-13,15,19,21 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) 10-13,19 and 25 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 2,3,15,21 and 26-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 November 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/12/03, 8/13/04 and 3/15/06.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date 6/21/07
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. The examiner had previously sent out a restriction requirement on 19 April 2007; however, the restriction requirement was not made in view of the preliminary amendment filed by the applicant on 12 November 2003. The applicant has cancelled claims 1, 4-9, 14, 16-18, 20 and 22-24 and added new claims 26-30 in the preliminary amendment. This office action corrects the previous error and examines claims 2, 3, 10-13, 15, 19, 21 and 25-30, which are currently pending in the application. Claims 10-13, 19 and 25 are withdrawn from consideration on the grounds that these claims are directed toward a non-elected invention. Claims 2-3, 15, 21 and 26-30 were confirmed as being the group of claims directed to the invention elected for the present prosecution, without traverse, in the election made over the phone on 4 June 2007 with Mr. David Yang (Reg. No. 44,415).

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 2-3, 15, 21 and 26-30, drawn to changing display components to small-scale display, classified in class 715, subclass 800.
 - II. Claims 10-13, 19 and 25, drawn to display and editing of musical notes, classified in class 084, subclass 483.1.
3. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the

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subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination teaches displaying a musical score sheet for editing notes.

Claim 10 does not mention effecting a small-scale display on a layer, and therefore, the feature taught in the subcombination of effecting small-scale display is not required for the combination.

Claim 10 is an evidence claim that indicates that the combination does not rely upon the specific details of the subcombination (claims 2-3, 15, 21 and 26-30) for its patentability. See MPEP 806.05(c) section II B. The subcombination has separate utility such as resizing components on the display screen in order to increase viewing efficiency, i.e. prevent overlap, ensuring objects fit on the screen, etc.; the subcombination can be used on any number of systems such as a windows management system, video editing system, etc. to resize component sizes.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

4. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a

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serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because it is longer than 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 2-3, 15, 21, 26-28 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Ohomori U.S. Patent 6,477,315.

Referring to claims 2, 15 and 21, Ohomori teaches a method, apparatus and computer-readable storage media comprising the steps of controlling the computer system to display a plurality of layers on a screen of the display (reference character 35 in Figures 7-8 shows the display of a list of different editing layers, or tracks for editing video content) (column 8, line 61-

column 9, line 12), wherein at least one execution icon corresponding to execution-related data can be attached to each of the layers (users can drag and drop icons 63A-63Y shown in Figure 9 onto portions of a track, or layer in the list of layers) (column 9, line 44-column 10, line 33); providing an instruction to control at least one of the layers to be subjected to small-scale display and controlling the computer system to perform the small-scale display on the at least one of the layers in response to the instruction (users can select the small-scale display button in between the minimize button “-” and the close button “x” shown in the layers window on the bottom half of the interface of Figure 5 to display the layer window, comprising at least one of the layers in small-scale form).

Referring to claim 3, Ohomori teaches restoring the layer from the small-scale display to normal-scale display in response to a mouse operation being effected on a prescribed portion of the layer (once the layers window comprising the layers are displayed in small-scale mode, the button between the minimize button “-” and the close button “x” shown in Figure 5 allows the user to redisplay the layer window in its original size).

Referring to claim 26, Ohomori teaches wherein the plurality of layers are vertically arranged on the display screen (as can be seen from Figure 5, the plurality of layers are arranged on top of each other vertically).

Referring to claim 27, Ohomori teaches wherein one or plural execution icons are arranged in the layer in a direction from the left to the right on the display screen in accordance with progress of the performance data (Figure 8 shows icons arranged from left to right on the layers in accordance with progression of the data, i.e. the timed ruler).

Referring to claim 28, Ohomori teaches wherein each layer is displayed as an execution icon layer corresponding to the execution-related data (as shown in Figure 8, the layers, or tracks shown in the editing list of tracks has special-effects processing icons attached to them).

Referring to claim 30, Ohomori teaches wherein when the execution icon attached to the layer is edited, edited content is reflected onto the performance data (the special-effect processing icons can be edited, i.e. moved by the user via a drag and drop operation; editing the video clip data according to the dropped location of the icon) (column 9, line 57-column 10, line 32).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohomori U.S. Patent 6,477,315, as applied to claims 2 and 28 above, and Weinstock et al. U.S. Patent 6,166,314 (hereinafter “Weinstock”).

Referring to claim 29, Ohomori teaches all of the limitations as applied to claims 2 and 28 above. However, Ohomori fails to explicitly teach wherein the execution icon layer contains at least one of a tempo icon layer, a dynamics icon layer, a joint icon layer, a modulation icon layer, an accent icon layer an attack icon layer, and a release icon layer.. Weinstock teaches an

interface for editing multimedia content similar to that of Ohomori. In addition, Weinstock further teaches wherein the execution icon layer contains at least one of a tempo icon layer, a dynamics icon layer, a joint icon layer, a modulation icon layer, an accent icon layer, an attack icon layer, and a release icon layer (Weinstock shows one of the execution icon layers contains a tempo icon layer) (Weinstock: Fig. 6, 606 and 610). It would have been obvious to one of ordinary skill in the art, having the teachings of Ohomori and Weinstock before him at the time the invention was made, to modify the execution layers of Ohomori to include layers related to musical performance, as taught by Weinstock. One would have been motivated to make such a combination in order to provide an automated system for allowing users to track musical scores and performances.

9. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach similar interfaces for editing performance data.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ting Zhou whose telephone number is (571) 272-4058. The examiner can normally be reached on Monday - Friday 7:00 am - 4:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached at (571) 272-4048. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TZ

TADESSE HAILU
PRIMARY EXAMINER
